



Paper No. 6

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OFFICE OF PETITIONS
AJC/PATENTS

In re Patent No. 5,793,270
Issue Date: August 11, 1998
Application No. 08/702,977
Filed: August 26, 1996
Attorney Docket No. A26996
Patentee: Nepela
Title: METHODS AND COMPOSITIONS
FOR OPTIMIZING PROPERTIES OF
MAGNETORESISTIVE SENSORS

DECISION GRANTING PETITION

In re Application of
Nepela
Application No. 09/648,006
Filed: August 3, 1998
Attorney Docket No. A26996
Title: METHODS AND COMPOSITIONS
FOR OPTIMIZING PROPERTIES OF
MAGNETORESISTIVE SENSORS

This is a decision on the petition under 37 CFR 1.53(e), filed December 21, 1998 and supplemented on March 8, 1999 and April 17, 2000, requesting that papers filed August 3, 1998, based on a prior application No. 08/702,977 be treated as a divisional application under 37 CFR 1.53(b), rather than under 37 CFR 1.53(d), and be accorded a filing date of August 3, 1998.

A Notice of Allowance was mailed in application No. 08/702,977 on November 12, 1997. A CPA request under 37 CFR 1.53(d) and the issue fee for application No. 08/702,977 was filed on February 9, 1998.

The CPA request was filed on February 9, 1998, while the prior application was still pending and was accompanied by a preliminary amendment, the filing fee, and a copy of the specification, drawings, and the signed declaration filed in the prior application. Petitioners state that they intended to file under 37 CFR 1.53(b) rather than 37 CFR 1.53(d). To support this position, petitioners point to the fact that they used the CPA request Transmittal, form PTO/SB/2, and specified that it was a request for a "Divisional application under 37 CFR 1.53(b)" (Emphasis added). Petitioners are

advised that if a request for a divisional application in a CPA Request Transmittal form also includes an instruction and/or reference that is inconsistent with the CPA practice, the request will be processed by the Office solely as a request for a divisional CPA under 37 CFR 1.53(d). See notice entitled "Continued Prosecution Application (CPA) Practice," 1214 O.G. 32(September 8, 1998).¹ The Office considers altering the CPA Request Transmittal form to list 37 CFR 1.53(b) rather than 37 CFR 1.53(d) an inconsistent instruction and processed the papers as a request for a divisional CPA under 37 CFR 1.53(d).

On February 9, 1998, the Office recognized the filing of the CPA under 37 CFR 1.53(d). At that point the prior application was expressly abandoned.

On May 28, 1998, a Notice of Allowance for the February 9, 1998 CPA was mailed. The issue fee filed on February 9, 1998 was applied to the issue fee due for the only viable application at the time -- the February 9, 1998 CPA. Therefore, the issue fee was paid on May 28, 1998.

A second CPA Request Transmittal based on prior application No. 08/702,977 was deposited on August 3, 1998. The August 3, 1998 request included inconsistent references with CPA practice which were disregarded. The CPA of August 3, 1998 was accompanied by an executed declaration under 37 CFR 1.63 and a specification including claims and drawings. However, the issue fee was paid in the prior application on May 28, 1998. Since the issue fee was paid prior to the filing of the CPA, the CPA was improper. A Notice of Improper CPA was mailed on February 25, 1999. Apparently the present petition was not matched with the application file until after this Notice was mailed.

The present petition requests that the application filed as a CPA under 37 CFR 1.53(d) be treated as a divisional application filed under 37 CFR 1.53(b).

The petition is **granted**.

The original divisional application papers filed on August 3, 1998 have been removed from the file of 08/702,977, and have been assigned Application No. 09/648,006. Copies of the original divisional papers have been placed in the file of application No. 08/702,977. These papers include a CPA request, a copy of the specification, drawings, and the signed declaration filed in the prior application, and a preliminary amendment. The original petitions to treat the August 3, 1998 filing as a divisional application under

¹ One of the purposes of this notice was to clarify the Office's existing practices for processing requests for a CPA under 37 CFR 1.53(d).

37 CFR 1.53(b), filed December 21, 1998 and March 8, 1999, respectively, the supplement to the petitions, filed April 17, 2000, and the letter to the examiner, filed September 16, 1998 have been transferred to application No. 09/648, 006. Copies of these papers have been placed in the file of application No. 08/702,977, also. All future correspondence relating to the divisional application should be directed to application No. 09/648,006.

After the mailing of this decision, Office records will be corrected to show that the fees paid on August 3, 1998 were paid in application No. 09/648,006, not in application No. 08/702,977. These fees include the \$790.00 filing fee, the \$328.00 fee for filing 4 additional independent claims, the \$22.00 fee for filing 21, rather than 20, total claims, and the \$130.00 petition fee.

A review of Office financial records indicates that petitioner paid twice for a petition to the commissioner. Petitioner may request a refund of the \$130.00 petition fee in the account associated with patent No. 5,793,279 by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

Application No. 08/702,977 (Patent No. 5,793,279) will be forwarded to Files Repository.

Application No. 09/648,002 is being returned to the Office of Initial Patent Examination for further processing as a divisional application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d), with a filing date of August 3, 1998, using the copy of the specification, drawings and declaration filed on August 3, 1998.

Telephone inquiries concerning this matter should be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.



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for Patent Examination Policy